

## REMARKS

Claims 1, 4, 10-13, and 16-27 have been cancelled without prejudice to the filing of divisional applications. Claims 28 and 29 have been withdrawn.

Claim 2 has been converted to independent form, and amended to include the substituent definitions from claim 1. In addition claims 2, 6, 8, 15, and 30 have been amended to remove the compounds where Q is -benzofuranyl-(C<sub>1</sub>-C<sub>4</sub>)alkyl-phenyl, benzofuranyl, benzothienyl, or phenyl. No new matter is added by these amendments.

New claim 31 has been added; no new matter has been introduced. Support for this claim can be found in Example 3 and original claim 30.

With these amendments, claims 2-3, 5-9, 14-15, 30, and 31 are pending.

### Rejections under 35 U.S.C. § 112, 1<sup>st</sup> paragraph

Claims 1-3, 5-9, 14-15, and 30 stand rejected under 35 U.S.C. § 112, 1<sup>st</sup> paragraph as failing to comply with the written description requirement. In particular, the Office objects to the proviso in claim 1.

Claim 1 has been cancelled overcoming this rejection.

### Rejections under 35 U.S.C. § 102

Claims 1-3, 5-9, 14-15, and 30 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Murthy et al. (2002), Malamas et al. U.S. Patent No. 6,232,322, Malamas et al. (2000), Malamas et al. WO99/58518, Schacht et al. U.S. Patent No. 4,072,754, and Bolhofer et al. DE 2307038.

#### Murthy et al. (2002)

All the compounds of Murthy contain biphenyl substituted with -benzofuranyl-(C<sub>1</sub>-C<sub>4</sub>)alkyl-phenyl, benzofuranyl, or benzothienyl moieties. Claim 2 has been amended to exclude the compounds of Murthy et al. (2002) wherein Q is -benzofuranyl-(C<sub>1</sub>-C<sub>4</sub>)alkyl-phenyl, benzofuranyl, or benzothienyl. Therefore, the compounds of Murthy et al. (2002) are not within the scope of the amended claims.

#### Malamas U.S. Patent No. 6,232,322 and Malamas WO99/58518

Malamas U.S. Patent No. 6,232,322 and Malamas WO99/58518 disclose three compounds where biphenyl is substituted with a benzofuranyl moiety. As noted above, the claims have been amended to exclude these compounds.

#### Malamas et al. (2000)

All the compounds disclosed by Malamas et al. (2000) contain biphenyl substituted with -benzofuranyl-(C<sub>1</sub>-C<sub>4</sub>)alkyl-

phenyl, benzofuranyl, or benzothienyl moieties. Claim 2 has been amended to exclude the compounds wherein Q is - benzofuranyl-(C<sub>1</sub>-C<sub>4</sub>)alkyl-phenyl, benzofuranyl, or benzothienyl, and as such is not anticipated by Murthy et al. (2002).

Schacht et al. U.S. Pat. No. 4,072,754

The Office asserts that Schacht et al. (U.S. Patent No. 4,072,754) discloses two compounds within the claims where a biphenyl moiety is substituted with -O-C(Me)(Ph)-CO<sub>2</sub>H (i.e., the carbon attached to L contains four non-hydrogen substituents). Applicants respectfully submit that the claims do not encompass these compounds because the carbon attached to L in claim 1 can only have three non-hydrogen substituents (e.g. -O-CH(R<sub>2</sub>)-(CH<sub>2</sub>)<sub>n</sub>-CO<sub>2</sub>H). In addition, these compounds are not within the scope of the amended claims because the Q-substituent cannot be H.

Bolhofer et al. DE 2307038

The Office asserts that a compound disclosed by Bolhofer et al. (DE 2307038), 2-(4'-chlorobiphenyl-4-yloxy)-2-(4-chlorophenyl)acetic acid, is encompassed by the claims. This compound is not within the scope of the claims because the claims are limited to compounds where the biphenyl moiety is further substituted with a ring Q (i.e. Q is pyrido[1,2-a]indolyl, indolyl, isoindolyl, indoliziny, imidazo[1,2-a]pyridine, etc.) Bolhofer's compound contains a biphenyl

moiety that is only substituted with chloro (i.e. Q is H), and as such is not within the scope of the claims.

In view of the above, Applicants respectfully request reconsideration and withdrawal of the rejections of claims 1-3, 4-9, 14-15, and 30 based on 35 U.S.C. § 102(b).

Claims 28-29 currently stand withdrawn from consideration as being drawn to non-elected inventions. However, in accordance with MPEP §821.04(b), if Applicants elect claims directed to a product which is subsequently found allowable, the withdrawn claims which depend from or otherwise require all the limitations of an allowable product claim will be considered for rejoinder. Upon rejoinder of claims directed to a previously non-elected invention, the restriction requirement between the elected product and rejoined claims will be withdrawn. It is submitted that the withdrawn claims as currently presented require all the limitations of the elected product (compound) claims. Thus, if the product claims are found allowable, the non-elected claims (withdrawn) should be rejoined.

Allowance of the claims and passage of the case to issue are respectfully solicited. The Applicants urge the Examiner to contact the Applicants' undersigned representative at (312) 913-0001, if he believes that a discussion would expedite prosecution of this application.

Respectfully submitted,

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